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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATTERSON, MARIE D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/07/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,059

Applicant(s)

QUELLAIS ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Claim Rejections - 35 USC § 112

1. Claims 17-20, 22-24, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17 the phrase "said rigid intermediate layer.....a succession of rigid inserts...", in claim 19 the phrase "...two arc-shaped recesses...", in claim 24 the phrase "which pass through said intermediate layer, or rib...." contradict the limitation of "said intermediate layer extending over an entire surface of said ground contacting layer" as claimed in claim 1 from which these claims depend rendering the claims confusing, vague, and indefinite.

In claim 22 the phrases "a principal mechanical ground-gripping zone", "a secondary position-maintenance or gripping zone" and "neutral central rear zone" are confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

Claim 23 in its entirety is confusing, vague, and indefinite. What element is being referred to by the phrase "the latter"?

In claims 26 and 27 the phrase "can allow mechanical attachment..." are functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. It is not clear what structural limitations applicant intends to encompass with such language.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 28 is rejected under 35 U.S.C. 102(a or e) as being anticipated by Tong (5185943).

Tong shows a shoe comprising a laminated profile sole comprising a ground contacting layer (118), an upper comfort layer (116), and an intermediate layer (120) which extends "over substantially an entire surface of said ground contact layer" as claimed.

4. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Barry (5052130).

Barry shows a shoe comprising a laminated sole comprising a ground contacting layer (16), a comfort layer (18), and an intermediate layer (20) which covers "substantially" an entire area of the ground contacting layer as claimed.

5. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Giese (5025573).

Giese shows a shoe comprising a laminated sole comprising a ground contacting layer (elements shown in figures 122-126 below element 31), a comfort layer (elements above element 31, note description on column 10, lines 1-33), an intermediate layer (31) "extending over substantially an entire surface of said ground contact layer" and which comprises in the metatarsal area, a succession of rigid inserts (31A) as claimed.

6. Claims 1, 2, 14-16, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuoka (4079526).

Fukuoka shows a sole comprising an intermediate layer (25), a ground contacting layer (35), and a cushion layer formed by points (29, 33, and 31) inasmuch as the claims and specification are understood.

7. Claims 1, 19, 20, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Salzman (4186500).

Salzman shows a sole comprising a ground contacting layer (11) which is molded and forms arc shaped stops at the toe and heel portions in "recesses" of an intermediate layer (30) which covers "the entire" ground contacting surface, and a comfort layer (50) inasmuch as the claims are understood.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 17, 18, 28, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of Giese (5025573).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering substantially the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines 37-46). Giese teaches extending a rigid intermediate layer

(31) into the metatarsal area and forming the metatarsal area as a succession of rigid inserts (31A). It would have been obvious to extend the intermediate layer into the metatarsal area and to form such as a succession of rigid inserts as taught by Giese in the sole of Misevich to increase support into the metatarsal area without reducing the flexibility of the metatarsal area.

10. Claims 1, 2, 4-14, 21-23, and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of either Hannibal (4651445) or Kurrash (4580359).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines

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37-46). Either Hannibal or Kurrash teaches extending a substantially rigid support layer (30 or 36) to cover the entire surface of a ground contacting layer. It would have been obvious to extend the intermediate support layer to cover the entire surface of the ground contacting layer as taught by either Hannibal or Kurrash in the shoe sole of Misevich to increase the geometrical extent/area covered by the stiffening formation as suggested by Misevich to increase the support/stiffness in the forefoot area of the shoe.

In reference to claims 5-10, Misevich as modified above discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the materials claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4-14, 21-23, and 25-28 above, and further in view of Banich.

Misevich as modified above shows a shoe sole substantially as claimed except for the comfort layer having different areas of elasticity. Banich teaches providing a midsole (figure 4) having zones of different material properties. It would have been obvious to provide the comfort layer with zones as taught by Banich in the shoe sole of Misevich as modified above to improve stability and natural biomechanics of the foot.

Response to Arguments

12. Applicant's arguments filed 9/29/03 have been fully considered but they are not persuasive.

In response to applicants' arguments and due to the decision in *Ex parte Eggert* (BPAI 5/29/03), the recapture objections/rejections have hereby been withdrawn.

In response to applicants' arguments directed towards the 112 second paragraph rejections, the phrases in claims 17, 19, and 24 as designated above, clearly contradict the limitation of the intermediate layer extending over the "entire" surface. It is noted that the addition of the term "entire" in the original application was done at a time when the dependent claims 17, 19, and 24 were withdrawn from examination and the fact that the Examiner at the time failed to note that these claims were indefinite is not persuasive.

In response to applicants' arguments directed towards Tong, the layer shown in figures 16 and 17 is considered to extend "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the shoe" as claimed. There is no guidance in applicant specification as to the limitations, i.e. what structures/how many spaces/eliminated areas would be encompassed by the term "substantially an entire", especially in view of applicants' arguments that the term "entire" in claim 1 is broad enough to have dependent claims which eliminate the layer in particular areas (i.e. claims 17, 19, and 24) and therefore the layer is not over the "entire" surface. In view of these arguments the limitation and structures applicant

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intends to encompass with the term "substantially an entire" is very unclear. Absent any further explicit claimed limitations these terms and other similar broad terms must be interpreted by the examiner in the broadest reasonable manner and the Examiner considers the layer shown in Tong to extend over "substantially an entire" surface as claimed. Tong clearly shows an intermediate layer which extends into the forefoot area (see figures 16 and 17) and since Tong and/or Barry shows all of the positively recited structures, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971).

In response to applicants' arguments directed towards Giese, Giese clearly discloses an upper cushioning layer which is molded above the stabilizing layers (see column 10 lines 1-33).

In response to applicants' arguments directed towards Fukuoka, Fukuoka clearly states that the outsole shown is to be used with "shoes sandals, slippers, etc." (see column 2 line 66). Also, it is noted that there are many types of sandal sport shoes and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicants' arguments directed towards the "cushioning" layer, elements 29, 33, and 31 are formed from the same material as the bottom layer, i.e. a soft synthetic resin (as discussed in column 4 lines 29-30), due to the use of this material these elements would provide cushioning.

In response to applicants' arguments directed towards Salzman, the insert of Salzman clearly extends over the entire surface as shown in figures 3 and 6 and described as such in the specification (specifically in the brief description of the drawings).

In response to applicants' arguments directed towards Kurrash, Kurrash clearly designates element 36 as a relatively hard material (column 2 line 42) which clearly can be considered to be a rigid support layer and inherently will provide some level of torsion control and flexional rigidity due to the relatively hard material used.

In response to applicants' arguments directed towards the teachings of Hannibal, Hannibal clearly discloses a stiffening layer of a composite/laminate sole which extends over the entire surface of the ground contacting layer of the sole. Hannibal also clearly teaches that the exact placement of the layer does not appear to be exclusive to the location shown (as suggested in column 7 lines 55-63). Hannibal clearly teaches extending a stiffening layer over the entire surface area of a sole.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

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Check out our web-site at "www.uspto.gov" for fees and other useful information.

A handwritten signature in black ink, appearing to read "Marie Patterson", with a long horizontal flourish extending to the right.

Marie Patterson
Primary Examiner
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